

REMARKS

This Amendment is responsive to the Official Action currently outstanding in the above-identified application and constitutes Applicants' submission accompanying the concurrently filed Request for Continued Examination in the above-identified application.

Claims 1-29 are pending in the above-identified application. Claims 7, 9, 11, 13, 15, 17, 19, 21, 23, 25, 27, and 28 stand withdrawn from further prosecution in the above-identified application by virtue of a prior election. Claims 1, 2, 4-6, 8, 22, 24 and 26 have been amended by the foregoing Amendment. Applicants do not propose the cancellation, the addition or the withdrawal of any further claims. Accordingly, upon the entry to the foregoing Amendment, Claims 1-6, 8, 10, 12, 14, 16, 18, 22, 24, 26 and 29 as hereinabove amended will constitute the claims under active prosecution in this application.

The claims of this application as they will stand upon the entry of the foregoing Amendment are set forth above including appropriate status identifiers as required by the Rules.

More specifically, in the currently outstanding Official Action the Examiner has:

1. Failed to re-acknowledge Applicants' claim for foreign priority under 35 USC §119 (a)-(d) or (f), and to reconfirm the receipt by the United States Patent and Trademark Office of the required copies of the priority documents; -
These matters were acknowledged in a previous Official Action and are referred to here solely for the sake of clarity in the record.
2. Failed to comment upon the acceptability of the drawings – **It is noted that the Examiner indicated in a previous Official Action in the above-identified application that the drawings as filed with this application on 1 August 2001 stand accepted. Accordingly, this matter also is mentioned here solely for the sake of clarity in the record;**

3. Previously acknowledged all of Applicants' Information Disclosure Statements filed in this application.
4. Rejected claims 1-6, 8, 10, 12, 14, 16, 18, 22, 24 and 29 under 35 USC§103(a) as being unpatentable over the Mazzagatte et al. reference (US Patent 6,862,583) in view of the Taniguchi reference (US Patent 6,348,972) and further in view of the Francis et al. reference (US Patent 6,650,430);
5. Rejected claim 20 under 35 USC 103(a) as being unpatentable over the foregoing references further in view of the Peters reference (US Patent 6,601,093), and
6. Rejected claim 26 under 35 USC 103(a) as being unpatentable in view of the Mazzagatte et al reference in view of the Taniguchi reference.

Further comment regarding items 1-3 above is not deemed to be required in these Remarks.

With regard to items 4-6, on the other hand, Applicants do not agree with the Examiner's conclusion that the claims of this application are unpatentable in view of the Mazzagatte, Taniguchi, Francis and Peters references, whether the same are taken alone or in combination with one another.

In addition, Applicants note that the Examiner again has taken the position that several of the features upon which reliance has been placed during the course of this prosecution are not recited in the rejected claims. Specifically, for example, Applicants note that the Examiner apparently feels that the claims of this application prior to the foregoing Amendment do not contain any limitation regarding the printing of numerous print jobs such that Applicants' previous arguments concerning the inapposite nature of the Francis reference to the present invention are not persuasive.

Applicants cannot agree with the Examiner's position on this issue because the claims of this application prior to the foregoing Amendment required "data preparation means for preparing operation data and identification data uniquely identifying the operation data" wherein **each** generated operation data is provided with its own identification data that is different from the identification data that may be associated with other operation data, i.e., "...identification data that uniquely identifies the operation data **in each instance of outputting**". Thus, it has been, and remains, Applicants' position that the claims of this application as they stood prior to the foregoing Amendment clearly, definitely and unambiguously defined the situation wherein **each (clearly encompassing multiple generations of operation data)** generated operation data was provided with its own distinct and separate identification data, rather than the situation wherein each (i.e., all) operation data of a recipient is associated with the same recipient identification data designating the recipient. In other words, the claims as previously written specifically called for each operation data to be associated with **different and unique** identification data, rather than that all of the operation data of a particular recipient was to be associated with a unique identification data representing that recipient (i.e., all operation data of the recipient associated with the **common, not different and unique,** identification data of the recipient). This situation has not changed (although it has been clarified) as a result of the foregoing Amendment. Hence, Applicants believe that the Examiner has improperly construed the claims of this application as to the manner that the combination of Mazzagatte and Fancis references applies thereto.

In summary, therefore, as was stated in the next previous Amendment in this application, "Applicants by the foregoing Amendment have amended all of the independent claims of this application so as to specifically indicate that the data preparation means prepares and outputs the operation data and further that the data preparation means also prepares and outputs **different** identification data that **uniquely identifies the operation data in each instance of outputting.**"

In addition, Applicants again respectfully submit that the fact was then, and now remains, that in the present invention envisions multiple (i.e., numerous) jobs associated with each operational data prepared in that as claimed different identification data is associated with each instance of outputting of operation data. This assertion is respectfully submitted to be fully supported by the present specification among other locations at Page 6, lines 14-23; Page 17, line 9 to page 20, line 16 (particularly, page 19, lines 15-23, referring to the identification data including a user ID and identification data prepared for each print job; and Page 17, lines 9-14, referring to each print data being identified precisely followed by example of types of data that might accomplish that goal that are clearly different from one another within each type listed); and the paragraphs bridging pages 18 and 19 as well as pages 40 and 41.

Accordingly, the Examiner's present attempt to resurrect the Francis reference that Applicant distinguished on the basis of its disclosed difficulty in loading and changing operational data and associated identification data previously loaded onto a so-called "small card" with respect to each of multiple print jobs is respectfully submitted to be insufficient in the present circumstances of this prosecution.

Similarly, the Examiner has chosen to read the "automatically" limitations of the present claims extremely (and seemingly unjustifiably) broadly so as to create support for his rejections based upon the Mazzagatte/Francis combination (i.e., construing "automatically upon approach" in a manner that it can be deemed to cover "presented" in any fashion including insertion). Applicants respectfully submit that this reading of the art simply stretches the Examiner's point too thin to justify the position that he is taking. The fact of the matter is respectfully submitted to be that "automatically" clearly and definitely means "without further outside input".

Thus, if there is a problem with the correct construction of the wording of the claims of this application, it lies in the construction of the word “approach”, not in the construction of the word “automatically”. Further, in the latter regard, Applicants respectfully submit that the Examiner’s position that the term “approach” is so broad as to encompass any “presentation” of the portable data storage means to the electronic device (including the insertion of a “small card” into the same) is beyond the scope of the broadest reasonable interpretation of the words of the claims of this application.

Accordingly, it will be understood that Applicants respectfully submit that while the word "approach" might be broad enough to cover the definition "being brought into the presence of" as suggested by the Examiner, the broadest reasonable interpretation arising from that definition of the term “approach” is not sufficient to cover the situation wherein the portable data storage device is inserted into the electronic device. In other words, Applicants respectfully submit that the word "approach" in the context of this invention and the present claims means being brought into the vicinity of (i.e., within a predetermined distance of) the electronic device in non-contacting relationship therewith. Any other construction of the word "approach" as utilized in the present claims is respectfully submitted to be contrary to the associated specification and therefore unreasonable in the context of the present invention such that the Examiner's assertions in support of his currently outstanding rejections cannot stand.

Applicants respectfully further submit that a similar line of reasoning applies with regard to the Examiner’s resurrection of the Peters reference that was discarded by the Examiner earlier in the present prosecution.

Thus, at page 4 of the currently outstanding Official Action, the Examiner's comment that "However, the Examiner contends that one skilled in the art would not replace the laptop computer, but rather provide another device for portable identification storage, which would still allow secure printing by identification information for both laptop and desktop users" (lines 6-9) is respectfully submitted to constitute a strained reading of the claims of this application beyond the broadest reasonable interpretation thereof. Indeed, Applicants respectfully submit that the fact of the matter is that the Peters reference discloses a laptop, not some other device for portable identification storage. Therefore, Peters does not teach, disclose or suggest any such "other device for portable identification storage". In this regard, therefore, Applicants respectfully call the Examiner's attention to the fact that in order to establish prima facie obviousness all of the claimed elements must be found in the applied art, not simply some sort of broad conceptual idea that is to be filled in by some sort of unsupported inherency argument to which the Applicants cannot effectively respond.

Accordingly, Applicants respectfully submit that as previously stated in this prosecution, the primary features of the present invention reside in that print data that is commanded by a personal computer or the like to be printed out is held in a storage device associated with the printer without being printed out, and information that uniquely identifies the so held print data is stored both in association with the print data to uniquely identify that print data and in a portable storage device **to uniquely identify that device**. Thus, when the user having the portable data storage device in his possession approaches (brings the portable data storage device within a preselected distance of) the target printer, the printer recognizes the information uniquely identifying specific print data that is stored in the storage device (i.e., recognizes the receipt of the presently claimed second identification data as a request for the print out of the specific print data associated with the presently claimed first identification information), and causes the so identified the print data held in the storage device to start to print out.

More specifically, in the present invention, the “approach” of the user who has the portable storage device in which the information uniquely identifying the print data is contained **as an identification of that device** in his possession allows the printer to carry out (i) an identification of a print request by the user, (ii) the identifying of the specified print data, based on information uniquely identifying the user (portable storage) and uniquely identifying the print data stored in the printer associated storage device (whether that storage be located at the site of the printer as in Mazzagatte or remote therefrom at one or more storage locations in a network as in Taniguchi), and (iii) to print-out the print data so uniquely identified for the user so uniquely identified.

Hence, Applicants again respectfully submit that with regard to independent Claim 1, for example, it should be noted that the claim recites *inter alia* **different** identification data that uniquely identifies the operation data outputted during each instance of outputting to the electronic device to identify the particular associated operation data, and portable storage means for receiving the unique identification data in the form of the same data that was used to identify the specific data stored in the printer storage. This feature is simply and definitely not taught or suggested by any of the presently cited references either alone or in combination with one another.

For these reasons, Applicants respectfully submit that the Examiner has not effectively rebutted their previous argument (repeated hereinbelow for convenience and completeness of this presentation) in the currently outstanding Official Action.

In an attempt to supply a teaching of the presently claimed portable storage means, the Examiner relies upon the smart (small) card, as taught by the Mazzagatte reference. It is respectfully noted, however, that the smart card of the Mazzagatte reference merely stores **authentication information indicating the user**. There is no teaching, disclosure or suggestion in the Mazzagatte reference regarding the storage of identification data that **uniquely identifies operation data** in the smart card discussed by the Mazzagatte reference.

Further, the Examiner cites the Francis reference as teaching “entering information into the memory of the smart card”, but the smart card of the Francis reference stores only a password and security mark images, not identification data as herein claimed. Applicants respectfully submit that it also should be recognized that the Francis reference teaches that once the smart card key has been programmed with a password, that password can only be changed under certain selected conditions or circumstances (see column 4, lines 24-28). Accordingly, Applicants respectfully submit that the best that can be said regarding the Examiner’s construction of the Francis reference is that it teaches, discloses or suggests that the changing of information on the smart card is not easily accomplished.

Consequently, Applicants respectfully submit that in the present circumstances if a job ID is to be stored on the smart card, the information on the smart card would need to be changed for every print job. This clearly would be impractical in the context of printing numerous jobs to the extent that Applicants respectfully suggest that it is clear that one of ordinary skill in the art at the time that the present invention was made would not have been lead to combine the Mazzagatte and Francis references in order to achieve the result achieved by the present invention. Rather, it only has been by utilizing the present invention as a basic framework that the Examiner has been able to pick and chose isolated elements of the prior art so as to recreate the present invention. Such clearly is not an acceptable way to establish the *prima facie* case under 35 USC 103(a) required to justify the Examiner’s currently outstanding rejections.

Independent Claims 22, 24 and 26 recite similar features to those just discussed with regard to Independent Claim 1, and Applicants respectfully submit that the Examiner’s rejections of those claims must fail for reasons similar to those just discussed with regard to Claim 1.

With respect to claim 20, the Examiner contends that the claimed features are taught by a combination of the Mazzagatte reference and the Peters reference. Applicants respectfully submit in this regard, however, that the Peters reference merely describes a wireless notebook computer that transmits data to a printer. Accordingly, one skilled in the art desiring to apply the Peters teachings to the device disclosed by the Mazzagatte reference would replace the laptop computer 20 of the Mazzagatte reference with the wireless computer of the Peters reference since the wireless computer of the Peters reference would be performing a similar function to that of the laptop computer of Mazzagatte. However, Applicants respectfully submit that such a substitution has nothing at all to do with the leading one of ordinary skill in the art to replace the smart card of the Mazzagatte reference with the wireless computer of the Peters reference.

Furthermore, the Examiner relies on the Peters reference as providing a teaching of the transmitting of information to a printer. In this regard it will be seen that the Peters reference describes two embodiments, namely, (1) a wireless computer establishing communications with a printer directly (without transmitting the information to a server) and (2) a wireless computer establishing communications with a server (see, Peters at Column 4, lines 41-50). However, a wireless computer establishing a communications with a server does not correspond to a wireless device transmitting information to a printer and thus cannot support the Examiner's position.

Nevertheless, despite the foregoing, in the interest of expediting the present prosecution and more clearly and definitively stating the subject matter that they regard as the invention, Applicants by the foregoing Amendment have extensively rephrased the claims of this application in a manner that is believed to more clearly define the present invention as the same is summarized in the present specification at Page 16, lines 11-17 as follows:

“In the printer 3 (*corresponding to the electronic device*), the data selector 14 identifies the user (*corresponding to the portable data storage device*) who directed a print job and approaches the printer 3, by collating the identification data received by the data transmitting/receiving section 17 with the identification data attached to the print data stored in the memory 15 of the printer 3 for management (*note that two kinds of identification data exist, and by collating those two kinds of identification data, it is determined which portable data storage means is approaching the printer*).

Thereafter, the print data to be output is specified and printing is carried out.”
(Parenthetical expressions in italics added)

Thus, it will be seen that the present invention provides an environment that allows a print job stored in a network printer that is shared among a plurality of users to be effectively, properly and securely printed. This is accomplished by preparing operation data for causing a particular print job to be printed in association with first identification data and providing the user with a portable data storage device that receives the first identification data as second identification data. Hence, the second identification data is such as to allow the printer to recognize the particular portable data storage device among all such portable data storage devices associated with the network and also to associate the operation data and the first identification data formed in association with the operation data with the recognized portable data storage device. The result of this is that each print job of each of the plurality of network users is individually located and output by the printer according to the point in time that each particular user goes to)”approaches”) the printer for the purpose of retrieving each of his individual print jobs as previously sent to the common network printer.

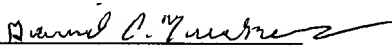
Applicants therefore respectfully submit that while the Examiner has cited art that teaches, discloses and/or suggests certain of the elements of the present claims or portions thereof, he nevertheless has not satisfied his burden of showing a valid *prima facie* case in support of his assertions that the claims of this application are unpatentable in view of the cited references whether taken alone or in combination with one another. Accordingly, Applicants respectfully submit that as hereinabove amended the claims of this application now are in condition for allowance. Therefore, entry of the foregoing Amendment, reconsideration and allowance of the present application in response to this communication are respectfully requested.

Finally, Applicants believe that additional fees are not required in connection with the consideration of this response to the currently outstanding Official Action filed as the required submission accompanying the concurrently filed Request for Continued Examination. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge and/or credit Deposit Account No. **04-1105**, as necessary, for the correct payment of all fees which may be due in connection with the filing and consideration of this communication.

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Respectfully submitted,

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